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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,108	03/31/2006	Peter Herold	2006-0446A	7425
513 7590 12/16/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
HABTE, KAHISAY				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
12/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,108

Applicant(s)

HEROLD ET AL.

Examiner

Kahsay T. Habte

Art Unit

1624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 11-14 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 11-21 are pending in this application.

Election/Restriction

2. Applicant's election without traverse of Group I, i.e. $X=Z$ = in formula (I) and formula (IA) = $-OCHR^{11}$ and $n = 0$ in the reply filed on 10/22/2009 is acknowledged. This election without traverse is based on applicant's suggested 4-way Restriction Requirement. For the record, the examiner did not agree with applicant's proposal over the telephone. The examiner indicated at the time of the interview that decision would be made after applicants submit their proposed Restriction Requirement in writing (see Interview Summary 10/21/2009). To expedite prosecution, the examiner would accept applicant's proposed Restriction Requirement for this case as shown below:

Group I $X-Z = -OCHR^{11}$ and $n = 0$.

Group II $X-Z = -O-CH_2CH_2-O-$

Group III $X-Z = -O-CHR^{11}C(O)NR_9$

Group IV $X-Z$ not encompassed by Group I-III.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action. It is recommended that applicants amend or delete the definitions

of n and Z according to the elected invention. A review of the proviso is also recommended.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

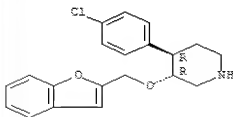
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-14 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Binggeli et al. WO 9709311. Cited reference teaches the following compound that is the same as applicants when applicant's formula (I) has the following substituents:

R² = phenyl substituted by chloro; and R¹ = benzofuranyl.

RN 188862-59-1 CAPLUS
CN Piperidine, 3-(2-benzofuranylmethoxy)-4-(4-chlorophenyl)-, (3R,4R)-rel-
(CA INDEX NAME)

Relative stereochemistry.



Since said compound is the same as applicants, a 102(b) rejection is proper.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-14 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

- a. In claim 11, the definition of R^2 is not clear. Applicants recite the definition of variable R^2 as follows:

R^2 is phenyl substituted by 1-3 halogen, hydroxyl, cyano, trifluoromethyl, C_{1-6} -alkyl, halo- C_{1-6} -alkyl, hydroxy- C_{1-6} -alkyl, C_{1-6} -alkoxy- C_{1-6} -alkyl, cyano- C_{1-6} -alkyl, carboxy- C_{1-6} -alkyl, C_{1-6} -alkanoyloxy- C_{1-6} -alkyl, C_{1-6} -alkoxycarbonyloxy- C_{1-6} -alkyl, C_{1-6} -alkoxycarbonyl, or C_{1-6} -alkoxy groups, or a C_{1-6} -alkylenedioxy group, and/or by an L1-T1-L2-T2-L3-T3-L4-T4-L5-U radical;

but it is unclear if a C_{1-6} alkylenedioxy group and/or L1-----U radical is a substituent on the phenyl ring or an independent definition of R^2 ?

- b. Claim 13 is rejected because the phrase " R^2 naphthyl or acenaphthyl" lacks antecedent basis. Claim 13 depends from claims 11 and 12, but there is no definition of R^2 = naphthyl or acenaphthyl back in claims 12 or claim 13..

Claim Objections

6. Claim 21 is objected to because of the following informalities: the phrase "A method for the preparation of a pharmaceutical preparation" appears to be garbled. It is recommended that applicants amend the claim as "A method for the preparation of a pharmaceutical composition".

Objection

7. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

8. Claim 18 is allowed.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kahsay T. Habte/
Primary Examiner, Art Unit 1624

December 16, 2009